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DAVID M. OLIVER

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EXAMINER

DESHPANDE, KALYAN K

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID M. OLIVER,
WILLIAM P. DENSMORE, JR. and MICHAEL J. CALLAHAN

Application 09/036,236
Technology Center 3600

Mailed: January 6, 2009

Before PAMELA S. BENNETT, *Review Team Paralegal*.

BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on August 14, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER

Appellants filed an Appeal Brief dated March 26, 2007. The Appeal Brief is not in compliance with 37 CFR § 41.37(c) effective September 13, 2004.

According to 37 CFR § 41.37(c) (v) (2006), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter*. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 6-28 of the Appeal Brief filed March 26, 2007 is deficient because it appears to map the independent claims to the specification by making reference to paragraph numbers instead of page and line numbers. Correction is required.

APPEAL BRIEF, EVIDENCE APPENDIX

37 CFR 41.37 states, in part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

....

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

. . . .

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

The Evidence Appendix is deficient because it does not appear to include a statement which sets forth where in the record the evidence was entered by the examiner. Correction is required.

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

1) to hold the Appeal Brief filed March 26, 2007 defective, as required by 37 CFR § 41.37(d);

- 2) to notify Appellants to submit a revised Appeal Brief which corrects the “Summary of Claimed Subject Matter” and “Evidence appendix”;
- 3) to acknowledge and consider the revised Appeal Brief; and
- 4) for such further action as may be required.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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